

## **REMARKS AND RESPONSES**

Claims 1,3,8 have been amended. Claims 12-18 are newly added.

Support for the amendments and newly added claims is found in the existing claims and specification as filed. Accordingly, the amendments and newly added claims do not constitute the addition of new matter.

As a result, claims 1-18 remain pending in the present application. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

### **Claim Rejection - 35 U.S.C. §103**

With respect to Paragraph 1 and 2 of the Office Action, the Office Action rejected claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over Zuckerman et al (US Patent No. 6,207,738). Of the rejected claims, claims 1 and 8 are independent.

Accordingly, applicants respectfully request that the rejection be withdrawn.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ*

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP §2143.03 All Claim Limitations Must Be Taught or Suggested)

Zuckerman et al truly discloses in col. 6, lines 6+, a gelatin, a hydrophilic material, can be used to form a shell of a microcapsule. It is appreciated that Zuckerman dose not think the gelatin, a hydrophilic material, is a suitable material for forming the shell of the microcapsule. Zuckerman says in col. 2, lines 9-24, “Moreover, some microencapsulated phase change materials have an internal layer of modified gelatin which is hydrophilic and capable of absorbing its own weight in water. Not only does the hydrophilic quality of such microcapsules make more standard component proportions inapplicable, microcapsules which have absorbed water tend to swell and associate, increasing the viscosity of the coating system above acceptable limits. . . . . . it is believed that such microcapsules agglomerate, reducing their dispersion throughout the binder of the coating system, which de-stabilizes the binder. This de-stabilization can increase over time. When latex binders are used with microencapsulated phase change material, de-stabilization of the latex binder can continue until the latex binder coagulates.” Briefly, the gelatin is not suitable for using to manufacture the shell of the microcapsule because the characteristic of

absorbing water to swell and associate, therefore, the microcapsules agglomerate and destabilize the binder.

The present invention discloses a fabric coating composition with latent heat effects, the composition comprises a hydrophilic microcapsule aqueous solution containing hydrophilic microcapsules with a shell made of a polymer polymerized from waterborne polyurethane and lipophilic monomer. Since Zuckerman et al fail to teach, suggest, or otherwise render obvious the same hydrophilic microcapsules with a shell made of a polymer polymerized from waterborne polyurethane and lipophilic monomer as the present invention, one can only come to a conclusion that the claimed invention proposes the features can not be obtained by Zuckerman et al.

However, the polymer polymerized from waterborne polyurethane and lipophilic monomer substantially does not absorb water. The disadvantages of the modified gelatin, a hydrophilic material, disclosed in Zuckerman et al can be improved by the composition disclosed in the claimed invention. Therefore, the novel features of claims 1 and 8 produce new and unexpected results and hence are unobvious and patentable over Zuckerman et al.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303

(Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984)

Besides, Zuckerman et al discloses the disadvantage of using the modified gelatin, a hydrophilic material. However, It could be an obvious and direct evidence that Zuckerman et al. do not appreciate the advantage of using hydrophilic material to form the shell of the microcapsule from the claimed invention. Since Zuckerman et al., could not achieve the purpose disclosed in claimed invention, a person skilled in the art would not modify Maloney according to Zuckerman et al.

Accordingly, Applicant respectfully submits that independent claims 1 and 8 as amended are allowable over the art of record and respectfully requests the 35 U.S.C. §103(a) rejection of claims 1 and 8 to be reconsidered and withdrawn. In addition, insofar claims 2-7, and 18 depend from independent claim 1, claims 9-17 depend from independent claim 8, and add further limitations thereto, the 35 U.S.C. §103(a) rejection of these claims should be withdrawn as well.

Reconsideration and withdrawal of this rejection is respectfully requested.

Other cited references of record have been studied, and are found no more relevant to the present invention than the applied art.

All claims in the present application are now in condition for allowance.  
Early and favorable indication of allowance is courteously solicited.

**Conclusions**

For all of the above reasons, applicants submit that the specification and claims are now in proper form, and that the claims define patentably over prior arts. Therefore applicants respectfully request issuance for this case at the Office Action's earliest convenience.

In the event this paper is not timely filed, applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayments to Deposit Account No. 50-236.

Respectfully submitted,



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